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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,396	03/09/2001	Akira Nonaka	09812.0625-00000	8707
22852	7590	12/11/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/803,396		NONAKA, AKIRA	
	Examiner		Art Unit	
	James A. Reagan		3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 26, 27 and 31-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 26, 27, and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

1. This action is in reply to the response filed on 23 October 2006.
2. Claims 1-18, 26, 27, and 31-35 remain pending and have been examined.

RESPONSE TO ARGUMENTS

3. Applicant's arguments received on 23 October 2006 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

The Examiner apologizes for the oversight regarding Hirai (US 6,839,503 B1). The rejections have been updated in response to the applicant's testimony.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

5. Claims 1-18, 26-27, 31-35 are rejected under 35 U.S.C. § 103 as being unpatentable Ryan (US 5,513,260 A), in view of Stefik (US 5,629,980 A).

Claims 1, 26, and 31:

Ryan (See at least Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) discloses a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit control. It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at least a decade with the advent of peer to peer file sharing) and is therefore believed to be the functional equivalent of the claimed limitations. Ryan does not explicitly disclose copying digital data an optical medium. Stefik, however, in at least column 1, lines 10-24 the reproduction of optical media. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist.

Ryan does not disclose the newly-added limitation of *wherein said usage space information indicates system information of said recording apparatus and said reproducing apparatus, ownership right information of said content data, format information of said content data, and distributing profit information obtained by the distribution of said content data*. Stefik however, in at least Figure 15 as

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well as associated text does disclose the controlled copying of digital data in a digital rights management environment to include system information (items 1504, 1505, 1506), ownership rights information (items 1501-1503), format of digital data (item 1506), and profit distribution (items 1517-1525). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cd recording system of Ryan/Hirai with Stefik's Digital Rights Management techniques because, "A fundamental issue facing the publishing and information industries as they consider electronic publishing is how to prevent the unauthorized and unaccounted distribution or usage of electronically published materials. Electronically published materials are typically distributed in a digital form and recreated on a computer based system having the capability to recreate the materials. Audio and video recordings, software, books and multimedia works are all being electronically published. Companies in these industries receive royalties for each accounted for delivery of the materials, e.g. the sale of an audio CD at a retail outlet. Any unaccounted distribution of a work results in an unpaid royalty (e.g. copying the audio recording CD to another digital medium)" (Stefik: column 1, lines 10-24).

Claim 2:

Regarding claim 2, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) substantially as claimed. The differences between the above and the claimed invention is the use of explicit authentication control. It is noted that a committed content duplicator would control and examine files illicitly copied (and has done so since for at least a decade with the advent of peer to peer file sharing) and is therefore believed to be the functional equivalent of the claimed limitations. Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist.

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Claim 3:

Regarding disabling limitations of claim 3, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 4:

Regarding disabling limitations of claim 4, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 5:

Regarding the enabling limitations claim 5, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 6:

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Regarding the enabling limitations claim 6, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 7:

Regarding disabling limitations of claim 7, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 8:

Regarding disabling limitations of claim 8, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 9:

Regarding the enabling limitations claim 9, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there

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between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 10:

Regarding the enabling limitations claim 10, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 11:

Regarding disabling limitations of claim 11, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 12:

Regarding disabling limitations of claim 12, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of

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evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 13:

Regarding the enabling limitations claim 13, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 14:

Regarding the enabling limitations claim 14, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 15:

Regarding disabling limitations of claim 15, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 16:

Regarding disabling limitations of claim 16, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 17:

Regarding the enabling limitations claim 17, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 18:

Regarding the enabling limitations claim 18, Ryan (See Fig. 1, Col. 1, lines 60-65, Col. 3, lines 30-65) disclose a means for reproducing content (cd player), a recorder and means there between for examining and controlling transfer (black boxes) for clear text cd which reproduction is enabled (that is common to all cd duplication systems) that is a functional equivalent of the claimed limitations.

Claim 27:

Regarding the encryption limitations claim 27, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan

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because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 32:

Regarding the encryption limitations claim 32, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 33:

Regarding disabling limitations of claim 33, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 34:

Regarding disabling limitations of claim 34, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan

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because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

Claim 35:

Regarding disabling limitations of claim 35, Stefik (See at least Figs. 15 and 16) show reproduction and recording means with system control and encryption/authentication. It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Ryan because the control elements are conventional functional equivalents and between reproduction and recording selection and control must always exist. Note that each of the applied items of evidence prevents and thus disables illegal copying that is a functional equivalent of the claimed limitations.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ANDREW J. FISCHER** can be reached at **571.272.6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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JAMES A. REAGAN

Primary Examiner

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04 December 2006

JAMES A. REAGAN
PRIMARY EXAMINER

